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DORR CARSON SLOAN & BIRNEY, PC
3010 EAST 6TH AVENUE
DENVER, CO 80206

EXAMINER	
JONES, SCOTT E	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/099,742	VANCURA, OLAF	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 March 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03142002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed May 29, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- In figures 1 and 2, items (24), (26), and (72) are not mentioned in the specification.
- In figure 6, items (610b), (610c), (200p), (200q), and (200r) are not mentioned in the specification.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "720" has been used to designate both a parrot and a program in figure 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The items noted hereinabove are not meant to be an exhaustive list of all of the informalities with the drawings. Applicant should review the drawings and submit corrections for all informalities discovered, including those noted by the examiner above.

Specification

5. The disclosure is objected to because of the following informalities:

- On page 5, lines 23-24, the phrase, "...programs in memory during for implementing..." is unclear.
- On page 6, line 6, the examiner believes "be" should be placed between "can" and "used".
- On page 7, lines 26-27, item (100a) is referred to as an underlying casino game, however, with respect to figure 2, (100a) is referred to as a slot machine.
- On page 8, line 12, slot machines are referred to as items (10), however, slot machines are previously referred to as (100a) on page 8, line 9 and in figure 2.
- On page 8, line 18, bonus game is referred to as (100), however, the bonus game is referred to as (100b) on page 8, line 9 and in figure 2.
- On page 10, line 1, the examiner is unsure how the bonus feature (200) starts the random statistical frequency (300) at which the bonus feature occurs. In figure 3, the method flow diagram indicates the random statistical frequency (300) occurs prior to the hidden bonus feature (200) by virtue of the arrow pointing from flow oval (300) to flow diamond (200).
- On page 10, line 3, the examiner believes "be" should be placed between "also" and "determined".

- On page 10, lines 7 and 8, event is referred to as item (200), however, event is referred to as (302) on page 10, line 6 and in figure 3.
- On page 10, line 11, a period should be placed at the end of the sentence ending with "embodiments".
- On page 10, line 20-page 12, line 6, applicant provides an example of event (302) as being four watermelons in combination or in alignment. Furthermore, applicant describes other variations of the event (302) wherein bonuses are provided for touching one or more of the watermelons. However, this example is not shown in any of the figures. Figures 1 and 2 show a (7, bonus, and star) symbol in combination around a pay line (90).

Correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

7. Claims 1, 7, 9, 13, 16, and 25-29 are objected to because of the following informalities:

- In claim 1, lines 4-6, the phrase, "the casino game not disclosing information to the player as to what the hidden bonus feature is and/or how the player responds to the hidden bonus feature" is unclear. The examiner believes reciting "the casino game not disclosing information to the player as to what the hidden bonus feature is and/or how the player is to respond to the hidden bonus feature" would make the claim clearer.

- In claim 7, line 3, "said" should be placed before "hidden".
- In claim 7, line 4, the examiner recommends the claim language, "players who don't know to correctly respond" be changed to "players who do not know how to correctly respond".
- In claim 9, line 3, "bonus" should precede "award" to make the claim language consistent throughout.
- In claim 13, lines 2-3, the phrase, "the bonus game is played in conjunction with an underlying gaming machine." is unclear. The examiner suggests the phrase in the claim be change to, "the bonus game is played in conjunction with an underlying game played on a gaming machine."
- It is noted that claim 16 recites "the Internet". While the term "Internet" is trademarked for goods and services, it is not presently trademarked for the service of a computer network. However, it is a term that is relative given both the rate at which technology is evolving, and misuse by modern media. The Internet is an infrastructure that supports the transmission of electronic data. It consists of all servers, routers, telephone lines, satellites, and other communications instruments used to convey electronic data, including Web sites, e-mail, usenets, and newsgroups, from one point to another. By using the term Internet, Applicant must be careful to delineate whether intending to claim the infrastructure of the Internet, or use of the infrastructure. Furthermore, what is accepted as the conventional scope of the Internet today, in terms of infrastructure, is quite different from that which was accepted as briefly as five years ago, and it is unknown what will be accepted as the

"Internet" of tomorrow. For these reasons, it is strongly urged that Applicant consider using more generic computer network terminology to claim the invention.

- Claim 25 should start with "A" rather than "The".
- In claim 26, the phrase, "the casino game is a gaming machine." is unclear because a casino game, such as a card game, can be played on a gaming machine.
- In claim 27, the phrase, "the casino game is an underlying gaming machine having a casino bonus game." is unclear. The examiner suggests the phrase in the claim be changed to, "the casino game is a underlying game on a gaming machine having a casino bonus game."
- In claim 28, lines 3 and 6, the examiner believes the phrase, "underlying gaming machine" should be changed to "underlying game on a gaming machine".
- In claim 28, the limitation recited in lines 10-13 is unclear. The examiner believes some text may be missing between the words "player" and "wherein" in line 11.
- In claim 29, line 2, "bonus" should precede "award" to make the claim language consistent throughout.

Correction is required.

8. The items noted hereinabove are not meant to be an exhaustive list of all of the informalities with the claims. Applicant should review the claims and submit corrections for all informalities discovered, including those noted by the examiner above.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. In claim 19, lines 1-2, the phrase, "the response from the player is the player touching the hidden bonus animated sequence." is unclear. Does the response from the player occur when the player touches the hidden bonus animated sequence on a touch screen?

12. In claim 23, lines 1-2, the phrase, "the response from the player is the player touching the hidden bonus feature." is unclear. Does the response from the player occur when the player touches the hidden bonus feature on a touch screen?

13. The items noted hereinabove are not meant to be an exhaustive list of all of the informalities with the claims. Applicant should review the claims and submit corrections for all informalities discovered, including those noted by the examiner above.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-8, 10-15, and 17-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Claypole et al. (G.B. 2,262,642 A).

Claypole et al. discloses a gaming machine having a secret feature wherein the feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine. The specific combination and the existence of the secret feature are not indicated on the gaming

machine panel at all. An award is provided based on a sequence of inputs made by the player in the game, however, the player need not know what sequence is required in order to obtain an award. Claypole et al. additionally discloses:

Regarding Claims 1, 25, and 28:

- providing a hidden bonus feature (secret feature) to the player in the casino game, the casino game not disclosing information to the player as to what the hidden bonus feature is and/or how the player responds to the hidden bonus feature, receiving a response (sequence of inputs made by the player) in the casino game from the player after providing the hidden bonus feature, delivering a bonus award in the casino game to the player when the response from the player is correct (Page 16, lines 4-20).

Regarding Claim 2:

- providing the hidden bonus feature occurs when one or a predetermined combination of game symbols appears in the casino game during play of the casino game (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 3:

- providing the hidden bonus feature occurs when a predetermined event (combination of symbols obtained on the reels of the gaming machine) occurs in the casino game (Page 16, lines 4-20).

Regarding Claim 4:

- providing the hidden bonus feature occurs when a hidden bonus feature display randomly occurs in the casino game (Page 16, lines 4-20). The secret feature is

triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 5:

- providing the hidden bonus feature occurs randomly (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 6:

- the existence of a hidden bonus feature is displayed on the casino game (Page 16, lines 4-20). Either a non-explanatory indicating sign appears on display screen (15) or the player realizes the hidden bonus feature has been enabled once the player is provided an award.

Regarding Claim 7:

- the bonus award is independent of the play of the casino game, thereby affording players who know how to correctly respond to hidden bonus feature a higher expected return than players who don't know to correctly respond to the hidden bonus feature (Page 16, lines 4-20).

Regarding Claim 8:

- the response is correct when an input is received from the player within a predetermined time period (the time period in which the gaming machine determines the sequence of inputs made by the player (Page 16, lines 4-20).

Regarding Claims 10 and 28:

- resuming play of the casino game occurs after the predetermined time frame times out (Page 16, lines 4-20). Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claim 11:

- play of the casino game continues during the predetermined time frame (Page 16, lines 4-20). Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claim 12:

- if the player provides a response for play of the casino game prior to providing a response for the hidden bonus feature, then the predetermined time frame immediately times out (Page 10, line 27, Page 16, lines 4-20, and Figure 1). If the player presses the collect button (18) upon entering the hidden bonus feature (secret feature), then the hidden bonus feature, as well as, game play, times out.

Regarding Claims 13 and 27:

- the casino game is a bonus game and wherein the bonus game is played in conjunction with an underlying gaming machine (Page 16, lines 4-20). Although independent from the secret feature, the casino game continues to be played during the secret feature.

Regarding Claims 14 and 26:

- the casino game is played in a gaming machine (Page 10, lines 5-27, Page 16, lines 4-20, and Figure 1).

Regarding Claim15:

- providing the hidden bonus feature originates in a controller of a progressive system connected to the casino game (Page 9, lines 3-5).

Regarding Claim17:

- the hidden bonus feature is an animated sequence (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 18:

- the hidden bonus animated sequence is a variation of animated sequences appearing in the casino game (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 19:

- the response from the player is the player touching the hidden bonus animated sequence (Page 6, line 19-Page 7, line 2, Page 8, lines 8-27, and Page 17, lines 3-4).

Regarding Claim 20:

- the hidden bonus feature is a graphic (picture or animation) (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 21:

- the graphic is a variation of graphics (pictures or animations) appearing in the casino game (Page 6, line 19-Page 7, line 2 and Page 17, lines 3-4).

Regarding Claim 22:

- the player is cued as to the hidden bonus feature (Page 16, lines 4-20). Either a non-explanatory indicating sign appears on display screen (15) or the player realizes the hidden bonus feature has been enabled once the player is provided an award.

Regarding Claim 23:

- the response from the player is the player touching the hidden bonus feature (Page 6, line 19-Page 7, line 2, Page 8, lines 8-27, and Page 17, lines 3-4).

Regarding Claim 24:

- the hidden bonus feature is provided at the same point (when a predetermined combination of symbols is obtained on the reels) in the casino game (Page 16, lines 4-20). The secret feature is triggered randomly via a combination of symbols obtained on the reels of the gaming machine.

Regarding Claim 29:

- the hidden bonus feature further displays a value for the award (Claim 4).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A).

Claypole et al. discloses to one of ordinary skill in the art that as discussed above regarding claims 1-8, 10-15, and 17-29. However, Claypole et al. seems to lack explicitly disclosing:

Regarding Claim16:

- playing of the casino game by the player occurs over the Internet.

However, to one having ordinary skill in the art at the time of Applicant's invention, operating a gaming device over a network, whether the network is a LAN, WAN, or the Internet, was notoriously well known. One would be motivated to operate the gaming machine over a network such that a casino management system could monitor all monetary exchanges between the gaming machines and players.

18. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claypole et al. (G.B. 2,262,642 A) in view of Walker et al. (U.S. 5,921,864).

Claypole et al. discloses to one of ordinary skill in the art that as discussed above regarding claims 1-8, 10-15, and 17-29. Furthermore, Claypole et al. discloses in one embodiment, the game offered on the screen could be a quiz/question/answer type game wherein the player is provided an award for answering a question correctly via the selection means (touch screen). However, Claypole et al. seems to lack explicitly disclosing:

Regarding Claim 9:

- the faster a player inputs a correct answer in the predetermined time period, the greater the award.

Walker et al., like Claypole et al., teaches of an electronic game that can be played on a gaming machine (computer) wherein a player is provided an award for solving a word puzzle. Therefore, Walker et al. and Claypole et al. are analogous art. Furthermore, Walker et al. teaches:

Regarding Claim 9:

- the faster a player inputs a correct answer in the predetermined time period, the greater the award (Column 2, lines 50-52 and Column 4, lines 48-56).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Walker's higher score for a faster solution feature in Claypole. One would be motivated to do so because providing a higher score (larger payout) for a correct answer provided in a shorter amount of time would add excitement to the game making the game highly entertaining to game players.

Double Patenting

19. Claims 1-29 of this application conflict with claims 1-27 of Application No. 10/196,607. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 1-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/196,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because dependent claim 23 of the instant application, as well as, claim 1 of conflicting Application No. 10/196,607, both recite the player input/response is the player providing a touch response on the hidden bonus feature.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Vancura '160, Fong et al. '512, and Anderson et al. '766 disclose gaming machines having bonus games that require a player input.
- Mastera et al. '666, Gura et al. '411, and Bennett '013 disclose gaming machines with bonus games having animation features.
- Vuong et al. '042 discloses a game system and method for a casino game operated over a network, such as the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713

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